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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,156

Applicant(s)

MURSCALL ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment, mailed April 28, 2003. Claim 1 was amended and claim 16 was added rendering claims 1-16 pending with claims 12-15 held to a non-elected invention.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. '...wherein said opaque white film further comprises reground is not supported by the specification.'

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-5 and ~~8~~-11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) as previously stated in the Office Action submitted on November 27, 2002. ⁵⁶⁶⁰²⁹³

As to the new limitation that 'wherein said crystallizable thermoplastic consists essentially of polyester' in claim 1, is rejected because Kim discloses a polymeric film comprising polyethylene terephthalate (crystallizable thermoplastic) comprising polyester and polyolefin (column 1, lines 57-67) where polyester is a polyolefin.

Claim Rejections – 35 USC § 103(a)

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) as previously stated in the Office Action submitted on November 27, 2002.

Claim Rejections – 35 USC § 103(a)

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of Yamazaki (U.S. 6,106,924) as previously stated in the Office Action submitted on November 27, 2002.

NONSTATUTORY DOUBLE PATENTING

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of Murschall et al. (U.S. 6,521,351). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include an opaque white film with a thickness of from 10 to 500 μm , wherein the film comprises a crystallizable thermoplastic consisting of polyester, barium sulfate and optical brightener. Additionally, both include the thermoplastic fed by way of masterbatch during film production. Although Murschall '351 does not explicitly disclose luminous transmittance, such luminous transmittance is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the luminous transmittance, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g.

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luminous transmittance) fails to render claims patentable in the absence of unexpected results. It would have been obvious to one of ordinary skill in the art to make the film with the limitations of the luminous transmittance since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

10. Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) have been considered but are unpersuasive. Applicant states claim 1 has been amended so as to limit the claimed group of crystallizable thermoplastics to those films consisting essentially of only polyesters and Kim discloses a combination of polyolefin and polyester resin. Although Kim discloses the film is composed on polyolefin and polyester, polyester is a polyolefin. Applicant argues one side effect of the polyester/polyolefin blend is a significant yellowing effect when regrind is used in the production of the film. It is immaterial what is used in the production of the film, because only the final product is given patentable weight in a structural claim. Regrind is a by-product of the film that is produced during the making of the film. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Applicant argues the

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film disclosed by Kim could not be used with regrind while still maintaining good optical and mechanical properties. Applicant lacks support for this ascertainment. Applicant argues it is surprising and unexpected that Applicant's film achieves such good mechanical and optical properties without heat stabilizers. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., good mechanical and optical properties without the aid of heat stabilizers) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues none of the examples use in Kim use barium sulfate as an inorganic particle. This argument is irrelevant because whether the reference discloses the barium sulfate as inorganic or not, the component remains inorganic material, absent any evidence to the contrary. Applicant further argues the instant invention does not desire to decrease friction, but rather to create an improved white opaque film, which is directed to intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant argues the respective methods of Kim differ from the methods used in the instant application.

This argument lacks relevancy because the patentability of a product does not depend on its method of production.

Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) have been considered but are unpersuasive. Applicant fails to disclose why this rejection is unobvious over the instantly claimed invention. Because the primary rejection has been upheld, the rejection of claim 6 as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) is upheld based on reasons of record.

Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of Yamazaki (U.S. 6,106,924) have been considered but are unpersuasive. Applicant fails to disclose why this rejection is unobvious over the instantly claimed invention. Because the primary rejection has been upheld, the rejection of claim 6 as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) is upheld based on reasons of record.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774



ELIZABETH MULVANEY
PRIMARY EXAMINER